

## REMARKS

Claims 1-2, 5-17, 20-26 and 29-35 remain pending in the present application. No new matter has been added.

### 101 Rejections

According to the present rejection, Claims 1-2, 5-17, 20-26 and 29-35 are rejected under 35 U.S.C. § 101 because the invention is directed to nonstatutory subject matter. Specifically, on page 4 at lines 17-18, Claims 1, 12 and 25 are stated as being directed toward non-statutory subject matter because the results produced by the steps are not tangible.

Applicants have reviewed the Examiner's reason for rejection under 35 U.S.C. §101 and respectfully submit that the rejection under 35 U.S.C. §101 of Claims 1-2, 5-17, 20-26 and 29-35 is improper and should be withdrawn.

Regarding Claims 1, 12 and 25, on page 4 section 11 of the present Office Action, the Examiner has stated, "[I]ndependent Claims 1, 12 and 25 merely recite "accessing end o product life materials planning parameters; accessing end of product life pricing parameters; and evaluating said end of product life materials planning parameters and said end of product life pricing parameters in conjunction to define said integrated action plan, wherein said integrated action plan is an end of product life integrated action plan" (emphasis added).

With respect to the above Examiner statements, Applicants respectfully disagree with the Examiner's interpretation of a tangible result.

In *re State Street*, 149 F.3d 47 USPQ2d 1596, 1600-1601 (Fed. Cir. 1998), it was held that the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm,

formula, or calculation, because it produces "a useful, concrete and tangible result"--a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades (emphasis added).

Furthermore, MPEP 2106 (2)(b) clearly states that the tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a 35 U.S.C. 101 judicial exception, in that the process claim must set forth a practical application of that judicial exception to produce a real-world result. *Benson*, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had "no substantial practical application."). "[A]n application of a law of nature or mathematical formula to a ... process may well be deserving of patent protection." *Diehr*, 450 U.S. at 187, 209 USPQ at 8 (emphasis added); see also *Corning*, 56 U.S. (15 How.) at 268, 14 L.Ed. 683 ("It is for the discovery or invention of some practical method or means of producing a beneficial result or effect, that a patent is granted . . ."). In other words, the opposite meaning of "tangible" is "abstract" (emphasis added).

In other words, Applicants respectfully submit that the present invention overcomes the tangible non-statutory subject matter requirements of 35 U.S.C. §101 when the invention produces a real-world result. That is, Applicant understands tangible result to refer to a result that is capable of being understood and evaluated, and therefore regarded as real.

For the above reasons, Applicants respectfully submit that Claims 1, 12 and 25 produce the useful, concrete and tangible result of " an integrated action plan, wherein said integrated action plan is an end of product life integrated action plan" (emphasis added). That is, the present Claimed invention produces the tangible result of a plan; and more specifically, an end of product life

integrated action plan. Moreover, the result, e.g., an end of product life integrated action plan, is capable of being understood and evaluated, and therefore should be regarded as real or tangible.

Thus, Applicants respectfully submit that independent Claims 1, 12 and 25 are directed to patentable subject matter, and as such their dependent Claims 2, 5-11, 13-17, 20-24, 26 and 29-35 are also directed to patentable subject matter. Accordingly, Applicants respectfully submit that an essential element needed for a *prima facie* rejection of Claims 1-2, 5-17, 20-26 and 29-35 is missing, and respectfully request review of the 35 U.S.C. §101 rejection of these claims.

#### Rejection under 103(a)

##### Claims 1-2, 5-17, 20-26 and 29-35

In the Office Action, the Examiner rejected Claims 1-2, 5-17, 20-26 and 29-35 under 35 USC 103(a) as being unpatentable over Huang et al. (6151582) in view of Zussman (Zussman, Eyal; "Planning of Disassembly Systems", Assemble Automation, 1995). Applicants have reviewed the cited reference and respectfully submit that the present invention is not rendered obvious over Huang et al. in view of Zussman for the following rationale.

Applicants respectfully submit that Independent Claim 1 (Claims 12 and 25 include similar features) includes the feature "defining an optimal end of product life integrated action plan for procurement, manufacturing, and marketing comprising:

- a) accessing end of product life materials planning parameters;
- b) accessing end of product life pricing parameters; and
- c) evaluating said end of product life materials planning parameters and said end of product life pricing parameters in conjunction to define said integrated action plan, wherein said integrated action plan is an end of product life

integrated action plan.” Support for the Claimed feature can be found throughout the Specification including page 8 lines 1-31.

Applicants have reviewed Huang et al. and agree with the Examiner that Huang et al. fails to explicitly teach a system that accounts for end of product life situations.

However, Applicants respectfully submit that the present invention is not rendered obvious over Huang et al. in view of Zussman for the following rationale.

MPEP 2141.01(a) I. states, in part,

“[I]n order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).”

Moreover, 2141.01(a) II. states, in part,

“[t]he court has found “the similarities and differences in structure and function of the inventions to carry far greater weight.” *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973).”

With respect to Zussman, Applicants respectfully submit that Zussman is nonanalogous art. Specifically, Applicants respectfully submit that Zussman is directed toward the planning of disassembly systems (emphasis added). That is, Applicants understand Zussman to teach maximizing the recycled resources and to minimize the mass and the pollution potential of the remaining products (introduction). Moreover, Applicants understand Zussman to teach disassembly as a new area in operation planning and management for applied recovery methods (emphasis added).

As such, Applicants do not understand Zussman to be within the field of manufacturing or end of product life integrated action plan for procurement, manufacturing, and marketing.

Thus, Applicants respectfully submits that Zussman is disqualified as Non-analogous art. As such, Applicants respectfully submit that the rejection of Claims 1-2, 5-17, 20-26 and 29-35 under 35 U.S.C. §103(a) with regard to Zussman is moot.

Therefore, Applicant respectfully submits that the shortcomings of Huang et al. as stated by the Examiner on page 6 of the Office Action with regard to Claims 1, 12 and 25 clearly provide the allowability of Claims 1, 12 and 25.

For this reason, Applicants respectfully state that Claims 1, 12 and 25 are not taught or rendered obvious over Huang et al. in view of Zussman. As such, Applicants respectfully submit that Claims 1, 12 and 25 overcome the rejection under 35 U.S.C. §103 (a) and that Claims 1, 12 and 25 are allowable.

In addition, Applicants respectfully submit that “[I]n order to establish a *prima facie* case of obviousness, the prior art must suggest the desirability of the claimed invention (MPEP 2142). In particular, “[i]t is improper to combine references where the references teach away from their combination” (emphasis added; MPEP 2145(X)(D)(2); *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)). Applicants respectfully note that “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention” (emphasis in original; MPEP 2141.02(VI); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)). Applicants respectfully submit that there is no motivation to combine the teachings of Huang and Zussman, because Zussman teaches away from the suggested modification.

As described above, Applicants respectfully agree with the Examiner that Huang does not teach or describe a system that accounts for end of product life situations, as claimed in independent Claim 1 and similarly recited in Claims 12 and 25. The Examiner relies in part on Zussman for providing such a teaching. However, Applicants respectfully note that the Zussman reference must be considered in its entirety in determining whether there is motivation or suggestion to combine Zussman with Huang (emphasis added).

As stated herein, Applicants understand Zussman to teach the planning of disassembly systems (emphasis added). Thus, as recited above, by disclosing that the end of life plan is a recycling or recovery method for disassembly of products, Zussman teaches away from the claimed embodiments of “defining an optimal end of product life integrated action plan for procurement, manufacturing, and marketing comprising: accessing end of product life materials planning parameters; accessing end of product life pricing parameters; and evaluating said end of product life materials planning parameters and said end of product life pricing parameters in conjunction to define said integrated action plan, wherein said integrated action plan is an end of product life integrated action plan” (emphasis added).

Applicants respectfully assert that there is no motivation or suggestion to combine these teachings. By teaching that the end of life plan is a “disassembly” plan, Applicants respectfully assert that Zussman teaches away from an end of product life integrated action plan for procurement, manufacturing and marketing.

Moreover, Applicants respectfully submit the combination of Zussman with Huang is improper because the references teach away from their combination. That is, a manufacturing method would obviously be teaching directly away from a disassembly and recycling method. In other words, Applicants respectfully submit that the two concepts, e.g., manufacturing and disassembling, could not be more contradictory or conflicting. As such, Applicants respectfully submit that

the combination as suggested by the Examiner is improper and should be withdrawn.

Thus, in view of the combination of Huang in view of Zussman not satisfying the requirements of a *prima facie* case of obviousness, Applicants respectfully submit that independent Claims 1, 12 and 25 overcome the rejection under 35 U.S.C. § 103(a), and that these claims are thus in a condition for allowance.

With respect to Claims 2 and 5-11, Applicants respectfully state that Claims 2 and 5-11 depend from the allowable Independent Claim 1 and recite further features of the present claimed invention. With respect to Claims 12-17 and 20-24, Applicants respectfully point out that Claims 12-17 and 20-24 depend from the allowable Independent Claim 12 and recite further features of the present claimed invention. With respect to Claims 26 and 29-35, Applicants respectfully point out that Claims 26 and 29-35 depend from the allowable Independent Claim 25 and recite further features of the present claimed invention. Therefore, Applicants respectfully state that Claims 2, 5-11, 13-17, 20-24, 26 and 29-35 are allowable as pending from allowable base Claims.

### CONCLUSION

Based on the arguments presented above, Applicants respectfully assert that Claims 1-2, 5-17, 20-26 and 29-35 overcome the rejections of record, and therefore, Applicants respectfully solicit allowance of these Claims.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,  
Wagner Blecher LLP

Date: \_\_\_\_\_

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